

REMARKS

The amendments find support in the specification and claims as originally filed. For example, the amendments to claims 1 and 27, and the subject matter of new claims 53-60, find support at pages 44-45 of the specification and in claims 38-46 as originally filed. No new matter is introduced by way of the amendments to the claims.

The conjugates of new claims 53 and 54 include the amino acid sequence of the light chain of the anti-IL-8 monoclonal antibody 6G4.2.5v11 (SEQ ID NO: 51). Such conjugates are novel and non-obvious at least for the reason that SEQ ID NO: 51 is novel and non-obvious. The conjugates of new claims 55-60 include amino acids 1-230 or the entire amino acid sequence of the anti-IL-8 monoclonal antibody heavy chain sequence of the humanized antibody 6G4.2.5v11 (SEQ ID NO: 60). The conjugates of claims 57 and 60 further comprise a leucine zipper sequence. Such conjugates are novel and non-obvious at least for the reason that SEQ ID NO: 60 is novel and non-obvious.

Claims 1 and 27 are pending in the application, and stand rejected as allegedly being obvious over Faanes et al. ("Faanes" U.S. Patent 5,695,760) in view of Zapata et al. ("Zapata" FASEB J. 9:1476, 1995) and Doerschuk et al ("Doerschuk" WO 95/23865). In addition, claims 1 and 27 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Zapata in view of Braxton ("Braxton" U.S. Patent No. 5,766, 897) and further in view of Doerschuk.

Claims 1 and 27 also stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 124 and 127-128 of copending application No. 09/489,394 in view of Doerschuk. Claims 1 and 27 are also rejected as allegedly not being patentably distinct from claims 124 and 127-128 of copending application No. 09/489,394. Claims 1 and 27 have also been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly not being patentably distinct from claims 1, 25 and 26 of copending application No. 09/726,258. Claims 1 and 27 have also been rejected under the judicially created doctrine of obviousness-type double patenting, it allegedly being obvious from

copending application No. 09/726,258 that a conjugate of 500 kD would be at least about 8 fold greater than the antibody fragment.

Applicants respectfully traverse these rejections.

The Rejections under 35 U.S.C. §103(a) over Faanes, Zapata and Doerschuk

Claims 1 and 27 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Faanes in view of Zapata and Doerschuk.

In order to establish a prima facie case of obviousness, there must be 1) some suggestion or motivation in the art or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1 and 27 have been amended to recite that the conjugates include an anti-IL-8 monoclonal antibody light chain sequence comprising amino acids 1-219 of the humanized antibody light chain 6G4.2.5v11 (SEQ ID NO: 51). None of the cited references Faanes, Zapata or Doerschuk teach or suggest the humanized antibody light chain 6G4.2.5v11 (SEQ ID NO: 51); moreover, none of the cited references teach or suggest an anti-IL-8 monoclonal antibody light chain sequence comprising amino acids 1-219 of the humanized antibody light chain 6G4.2.5v11 (SEQ ID NO: 51). Lacking these elements, these references also fail to provide any motivation to combine the references to provide them, and provide no reasonable expectation that such a combination would be successful.

Accordingly, since Faanes, Zapata and Doerschuk all fail to disclose at least these elements of claims 1 and 27; fail to provide any motivation to combine the cited references to provide the claimed invention, and fail to provide a reasonable expectation of success were the references to be so combined, applicants respectfully submit that claims 1 and 27 are not made obvious by the cited references.

Accordingly, Applicants respectfully submit that the rejections of claims 1 and 27 under 35 U.S.C. § 103(a) as allegedly being obvious over Faanes in view of Zapata and Doerschuk are overcome.

The Rejections under 35 U.S.C. §103(a) over Zapata, Braxton and Doerschuk

Claims 1 and 27 have been rejected under 35 U.S.C. § 103(a) as obvious over Zapata in view of Braxton and further in view of Doerschuk. As discussed above, these claims have been amended to recite that the claimed conjugates include an anti-IL-8 monoclonal antibody light chain sequence comprising amino acids 1-219 of the humanized antibody light chain 6G4.2.5v11 (SEQ ID NO: 51). Zapata and Doerschuk have been discussed above as lacking any disclosure or suggestion of SEQ ID NO: 51 or portions thereof. Braxton similarly lacks any disclosure or suggestion of humanized antibody 6G4.2.5v11 light chain (SEQ ID NO: 51) or of amino acids 1-219 of SEQ ID NO: 51.

Thus, the references Zapata in view of Braxton and further in view of Doerschuk fail to disclose at least these elements of claims 1 and 27; fail to provide any motivation to combine the cited references to provide the claimed invention, and fail to provide a reasonable expectation of success were the references to be so combined, applicants respectfully submit that claims 1 and 27 are not made obvious by the cited references.

Accordingly, Applicants respectfully submit that the rejections of claims 1 and 27 as allegedly being obvious over Zapata in view of Braxton and further in view of Doerschuk are overcome.

Common Ownership Applications 09/355,014 and 09/489,394

The Examiner has required a showing that “the conflicting inventions were commonly owned at the time the invention in this application was made” or that “the prior inventor of the conflicting subject matter” be named (page 4, paragraph 2 of the Office Action).

As a result of their employment agreements, at the time of invention, the inventors of the present application 09/355,014 were under an obligation to assign

these inventions to Genentech, Inc. The inventors did assign the inventions to Genentech, Inc., as shown by the assignment documentation for application 09/355,014, which was recorded on 1/16/2001 at Reel/Frame 011458/0859 (copy enclosed).

Similarly, as a result of their employment agreements, at the time of invention the inventors of application 09/489,394 were under an obligation to assign those inventions to Genentech, Inc. They did assign the inventions to Genentech, Inc., as shown by the assignment documentation for application 09/489,394, recorded on 10/03/2000 at Reel/Frame 011202/0462 (copy enclosed).

Thus, both the present application 09/355,014 and the commonly assigned 09/489,394 application were owned by Genentech at the time the invention of the present application was made.

Accordingly, applicants respectfully submit that rejections of claims in the present application under 35 U.S.C. § 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. § 102(f) or 35 U.S.C. § 102(g) are precluded by the showing that the inventions were commonly owned at the time of the invention. For the same reason, and in addition because the present application was filed before November 29, 1999, rejections under 35 U.S.C. § 102(e) are also believed to be precluded.

The Provisional Double-Patenting Rejections over co-pending Application No. 09/489,394 in view of Doerschuk

Claims 1 and 27 have been provisionally rejected under the judicially created doctrine of double patenting in view of claims 124 and 127-128 of co-pending Application No. 09/489,394 in view of Doerschuk. However, as discussed above, Doerschuk fails to teach or suggest at least the element SEQ ID NO:51 of claims 1 and 27. Similarly, claims 124 and 127-128 of co-pending Application No. 09/489,394 fail to recite SEQ ID NO:51. Accordingly, claims 124 and 127-128 of co-pending Application No. 09/489,394 in view of Doerschuk fail to disclose at least these elements of claims 1 and 27; fail to provide any motivation to combine the cited references to provide the

claimed invention, and fail to provide a reasonable expectation of success were the references to be so combined, applicants respectfully submit that claims 1 and 27 are not obvious in view of claims 124 and 127-128 of co-pending Application No. 09/489,394 in view of Doerschuk.

Claims 1 and 27 have also been rejected as allegedly not being patentably distinct from claims 124 and 127-128 of copending application No. 09/489,394. However, as discussed above, claims 124 and 127-128 of co-pending Application No. 09/489,394 do not recite SEQ ID NO:51 nor amino acids 1-219 of SEQ ID NO:51. Accordingly, lacking at least these claim elements, applicants respectfully submit that claims 1 and 27 are patentably distinct from claims 124 and 127-128 of copending Application No. 09/489,394.

The Provisional Double-Patenting Rejections over co-pending Application No. 09/726,258

Claims 1 and 27 have also been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly not being patentably distinct from claims 1, 25 and 26 of copending application No. 09/726,258. However, claims 1, 25 and 26 of co-pending Application No. 09/726,258 do not recite SEQ ID NO:51, nor do they recite amino acids 1-219 of SEQ ID NO:51. Accordingly, lacking at least these claim elements, applicants respectfully submit that pending claims 1 and 27 are patentably distinct from claims 1, 25 and 26 of copending Application No. 09/726,258.

Claims 1 and 27 have also been rejected under the judicially created doctrine of obviousness-type double patenting, it allegedly being obvious from copending application No. 09/726,258 that a conjugate of 500 kD would be at least about 8 fold greater than the antibody fragment. However, the claims in copending Application No. 09/726,258 lacking at least the claim elements SEQ ID NO:51 and amino acids 1-219 of SEQ ID NO:51, applicants respectfully submit that this ground of rejection is moot, and that claims 1 and 27 are not obvious in view of the claims of copending Application No. 09/726,258.

Accordingly, Applicants respectfully submit that claims 1 and 27 are not obvious in view of the cited applications.

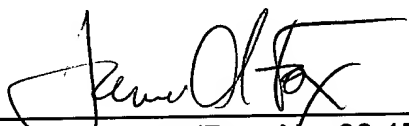
CONCLUSION

Applicants respectfully submit that the rejections to claims 1 and 27 are overcome by the above arguments and amendments. Accordingly, applicants respectfully submit that claims 1, 27, and 53-60 stand in condition for allowance, and request the reconsideration of claims 1 and 27 and the allowance of all claims.

Please charge any additional fees, including any fees for extension of time, or credit overpayment to Deposit Account No. 08-1641 referencing Attorney's Docket No. 39766-0091 NP.

Respectfully submitted,

Date: September 17, 2003

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9/17/03 11:22 AM (39766.0091)